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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,637	11/08/2001	Travis J. Parry	10008075-1	1866

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400.

EXAMINER
WINDER, PATRICE L

ART UNIT	PAPER NUMBER
2145	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/006,637	PARRY, TRAVIS J.
	Examiner	Art Unit	
	Patrice Winder	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 October 2006</u>.

2a)☒ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,5-15 and 21-27* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-2,5-15, 21-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Double Patenting

1.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2.   Claims 7-15, 23-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 23 of U.S. Patent No. 6,666,594 B2.

3.   Claims 7-15, 23-24 of the instant application is anticipated by patent '594 claim 23 in that claim 23 of the patent '594 contains all the limitations of claim 7 of the instant application. Claim 7 of the instant application therefore is not patently distinct from the earlier patent claim and as such is unpatentable for obvious-type double patenting. The following explains the relationship between Claim 7 of the instant application and claim 23 of patent '594:

Claim 7 omits requesting additional error information.

Claim 7 designates a specific error type, i.e. transmittal errors. Because

transmittal errors are a specific type of error, transmittal errors are within the scope of

the "errors" of claim 23.

Claim 7 adds the feature of conveying the errors automatically which is an

obvious variation of the claim 23. The addition of limitations to a patented claim is an

obvious variation.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

5.   Claims 7, 8, 9, 21 and 26 rejected under 35 U.S.C. 112, first paragraph, as failing

to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. The amendment and newly presented claims

include the limitation (and its variations) of error messages "automatically conveyed

over the network with a web server in response to detection of the transmittal error".

According, the specification at paragraphs [0028] – [0030], the errors are conveyed after

being detected. This is not exactly the same as being "in response to detection".

Applicant's amendment introduces "new matter" with the concept of "responsive to

detection".

6.   Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had

possession of the claimed invention. A "first plurality of printers" "running a first set of

software programs" and "a second plurality of printers" "running a second distinct set of

software programs". Applicant's disclosure as originally filed does not divulge the

concept of "distinct" software programs. Inclusion of such a concept is new matter.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

8.   Claims 1-6, 21-22 and 25-26 are rejected under 35 U.S.C. 102(e) as being

anticipated by Bernklau-Halvor, US 6,782,495 B2 (referred to as Bernklau-Halvor).

9.   Regarding claim 1, Bernklau-Halvor taught a system for garnering information on

printer errors (abstract), comprising:

a plurality of printers (column 4, lines 10-19), each printer incorporating a web

server linked to a network (column 6, lines 16-28), each printer including an error

detector for detecting error in printing functions (column 4, lines 45-55; column 6, lines

34-35);

at least one receiving computer in communication with said network, said at least

one receiving computer having a memory thereon (column 11, lines 21-29); and

at least one online error database stored within the memory of said at least one

receiving computer, said at least one online error database capable of receiving an error

message generated by any of said plurality of printers (column 15, lines 27-31) and

conveyed over said network (column 15, lines 27-34).

10.   Regarding dependent claim 2, Bernklau-Halvor taught the method further

comprising at least one workstation in communication with the said network, said one

workstation capable of originating a print job which may be conveyed to said printer

over said network (column 4, lines 31-32; column 5, lines 22-25).

11.   Regarding dependent claim 5, Bernklau-Halvor taught said network comprises

the Internet (column 4, lines 10-19).

12.   Regarding dependent claim 6, Bernklau-Halvor taught said network is comprises

a local area network (column 4, lines 10-19).

13.   Regarding dependent claim 21, Bernklau-Halvor taught the printer is configured

to automatically generated and convey the error message over the network to the at

least one online error database upon detection of an error (column 15, lines 27-31).

14.   Regarding dependent claim 22, Bernklau-Halvor taught the error message is

selected from the group of error messages consisting of: a transmittal error message, a

process error message and an output error message (column 6, lines 16-30).

15.   Regarding claim 25, Bernklau-Halvor taught a method (abstract) comprising:

detecting a first error at a first printer incorporating a first web server (column 4, lines

45-55; column 6, lines 34-35);

generating a first error message at the first printer (column 6, lines 34-35);

conveying the first error message to a first online error database with the first

web server over a network (column 6, lines 16-30);

detecting a second error message at the second printer incorporating a second

web server (each printer is capable, column 4, lines 10-19; column 6, lines 16-23);

generating a second error message at the second printer (column 6, lines 34-35);

and

conveying the second error message to the first online error database with the

second web server over a network (column 6, lines 16-30).

16.   Regarding dependent claim 26, Bernklau-Halvor taught the first error message is

automatically conveyed to the online error database in response to the detection of the

first error (column 15, lines 27-31).

Response to Arguments

17.   Applicant's arguments filed October 5, 2006 have been fully considered but they

are not persuasive.

18.   Applicant argues – "Claim 23 of US Patent 6,666,594 does not recite

automatically conveying transmittal error messages over a network in response to

detection of the transmittal error."

   a.   Applicant supports the addition of the concept of "automatically" conveying

with paragraphs 28-30 of the specification with the context of paragraph 5. The

disclosure of USPN 6,666,594 provides that "rather than writing the error

message to the printer error archive 27, the error message could be instead

conveyed to a network administrator or other user, as an email ..." (column 8,

lines 20-25). Meaning that scope of "conveying" in USPN 6,666,594 includes

automatically conveying which is suggested by generation of emails conveying

the error messages.

19.   Applicant argues – "Bernklau-Halvor fails to disclose a system having an error

database that receives error messages from multiple computers [printers]... The use of

'printers' clearly does not mean that database receives error information from multiple

distinctive printers."

   b.   First, applicant claims a "plurality of printers" in claim 1 but does not claim

"distinctness", per se. Second, the examiner disagrees that the term "printers" is

not meant to be plural. Bernklau-Halvor taught a plurality of printers (see column

4, lines 10-17) and each printer possesses usage information, see column 4,

lines 45-50. Thus, the representative behavior of one of printers is followed by all

of the printers, which explains the context of column 15, lines 27-31.

20.   Applicant argues – "Claim 7 ... recites that the transmittal error message is

automatically conveyed over the network with a web server in response to detection of

the transmittal error. Support for such amendments to claim 7 as well as for similar

amendments to claims 8-9 "can" be found in at least paragraphs [0028] – [0030] in the

context of Paragraph [0005].

.c.   Claim 5 provides context for the motivation of automatically conveying

error messages. However, at what point the conveyance is initiated is not

supported by the paragraphs cited. The only information that can be gleaned

from the citations provided is that it might occur after an error is detected but not

necessarily "responsive" to the error. The distinction being that "responsiveness"

provides for a much more immediate reaction and originally filed specification is

silent on that concept.

Conclusion

21.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

22.   Kaufman et al., USPN 7,126,716 B1: taught a printer with an embedded web

server which is configured to automatically transmit data such as critical and non-critical

data.

23.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the
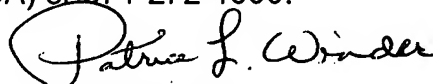
shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

24.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Patrice Winder whose telephone number is 571-272-

3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patrice Winder
Primary Examiner
Art Unit 2145

December 23, 2006